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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,672	04/21/2006	Makoto Sanpei	14048-029	7213
80711	7590	06/29/2010		
Brinks Hofer Gilson & Lyon/Ann Arbor			EXAMINER	
524 South Main Street			LENIHAN, JEFFREY S	
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Ann Arbor, MI 48104			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			06/29/2010 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/576,672

**Applicant(s)**

SANPEI ET AL.

**Examiner**

Jeffrey Lenihan

**Art Unit**

1796

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 June 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:  
a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
b) ☐ They raise the issue of new matter (see NOTE below);  
c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-6 and 9-12

Claim(s) withdrawn from consideration: \_\_\_\_\_

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

/ Irina S. Zemel/  
Primary Examiner, Art Unit 1796

Continuation of 3. NOTE: Applicant has amended the claims to require that the claimed olefin oligomer (b) has a number average molecular weight (Mn) in the range of 400-1000; this narrower range was not recited in any previous version of the claims. The proposed amendment therefore raises new issues and would require further search and consideration to determine patentability.

Continuation of 11. does NOT place the application in condition for allowance because: Regarding the supplemental response filed on 6/25/2010: The examiner notes that neither the response filed on 6/17/2010 nor the supplemental response filed on 6/25/2010 is compliant under 37 CFR 1.121. Claims 2 and 12 have both been amended but are incorrectly marked with the status identifiers "Previously presented" and "New," respectively. Any future submissions should be prepared in compliance with 37 CFR 1.121. As the supplemental reply is a noncompliant amendment, it has not been entered into the record (see MPEP 714.03(a)).

Arguments regarding an oligomer having a Mn in the range of 400 to 1000 are directed towards an invention defined by a combination of limitations not recited in the currently pending claims and therefore are not germane to the patentability of said pending claims. Furthermore, the mere fact that the prior art allows for the use of oligomers having a lower limit than that disclosed by applicant is not sufficient to establish the criticality of the claimed range. Arguments regarding the lower limit of the Mn in Yang and the overlap of the claimed range and prior art range are addressed in the previous Office Action, incorporated herein by reference.

Regarding the argument that Ikemoto is directed towards the fabrication of hoses: As stated in the Office Action mailed on 12/15/2009, Ikemoto explicitly states that the prior art composition may be used in rubber vibration insulators. The prior art therefore is not restricted to the development of hoses.

Arguments regarding the use of the oligomer of Yang with an EPDM were previously addressed in the Office Action mailed on 11/03/2009, incorporated herein by reference.

Regarding the allegedly unexpected results: Inventive Examples 1-3 comprise an oligomer having a Mn of 690; this value is 72.5% greater than the claimed limit of 400. The inventive examples are compared to comparative example 4 which comprises an oligomer having Mn of 287; this value is 28.3% less than the claimed limit of 400. Because the Mn in the comparative example is significantly closer to the claimed lower limit of 400 than the Mn in the inventive examples, the examiner takes the position that applicant has not established the criticality of the claimed lower limit. No data has been presented for the higher portion of the claimed range; applicant therefore has not demonstrated that the allegedly unexpected results may be obtained commensurate in scope with the claimed invention.